

REMARKS

Claims 23, 24, 26, 27 and 28 are pending in the present application. Claim 23 was previously presented and the amendments were not entered. Claims 24 and 26 have been amended without prejudice and without acquiescence. Support for the amendments can be found in the Specification on page 13, lines 3-4; Fig. 25; page 17, lines 19-25; and page 35, line 30. Claim 25 has been canceled without prejudice and without acquiescence. Claims 27 and 28 have been added. Support for claims 27 and 28 can be found throughout the Specification, for example, page 6, lines 26-31; page 7, lines 4-17; page 41, lines 8-30; and page 42, lines 1-25. The Examiner has indicated in the Advisory Action that claim 23 contains allowable subject matter. Further, the Examiner indicated during the Telephonic Interview that the amendments to claims 24 and 26 would put the claims in condition for allowance. Applicants retain the right to file a continuation and/or a divisional application to any canceled claims. No new matter has been added.

The issues outstanding in this application in the Office Action dated August 26, 2003 are as follows:

- Claim 23 was rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Burglin et al. (Genes Dev., 1987).
- Claims 24 and 26 were rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Fu et al. (US Pat No. 6090620, filing date December 1996).

Applicants respectfully traverse the outstanding rejections, and Applicants respectfully request reconsideration and withdrawal thereof in light of the amendments and remarks contained herein.

I. Rejection under 35 U.S.C. § 102(b)

Claim 23 is rejected under 35 U.S.C. § 102(b) as being anticipated by Burglin et al. (Genes Dev., 1987). Applicants respectfully traverse.

Anticipation of a claim is only established where “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987).

In the previous response dated October 23, 2003, in which the amendment was not entered, Applicants amended claim 23 without acquiescence and prejudice to indicate an isolated polynucleotide having the polynucleotide sequence set forth in Fig. 25 (SEQ ID NO:16). Burglin et al. does not teach the polynucleotide sequence set forth in Fig. 25 (SEQ ID NO:16).

In the Advisory Action, the Examiner indicated that this rejection has been overcome and claim 23 is allowable. Thus, Applicants respectfully request that the amendment be entered.

II. Rejection under 35 U.S.C. § 102(e)

Claims 24 and 26 are rejected under 35 U.S.C. § 102(e) as being anticipated by Fu et al. (US Pat No. 6090620). Applicants respectfully traverse.

Anticipation of a claim is only established where “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987).

In order to further the prosecution of the present application, Applicants have amended claim 24 without acquiescence and without prejudice to indicate an isolated polynucleotide that specifically hybridizes under hybridization conditions of about 0.3 M NaCl at temperatures of about 50°C to about 55°C with the polynucleotide of claim 23 in which the encoded protein modulates fertility. One of ordinary skill in the art recognizes that the polynucleotide sequence of Fu et al. will not hybridize under the conditions of claim 23

nor does the polynucleotide sequence of Fu et al. encode a protein that modulates fertility. Therefore, Fu et al. is precluded from anticipating the present claim 24. Thus, Applicants respectfully request withdrawal of the rejection.

In order to further the prosecution of the present application, Applicants have amended claim 26 without acquiescence and prejudice to indicate an isolated polynucleotide that is fully complementary to the polynucleotide sequences of claims 23 or 24. In the Advisory Action, the Examiner indicated that previously presented claim 23 was allowable and during the Telephonic Interview the Examiner indicated that amended claim 24 should be allowable. Thus, since dependent claim 26 further includes the limitations of claims 23 and 24, Fu et al. is precluded from anticipating the present claim 26. Thus, Applicants respectfully request withdrawal of the rejection.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

In an accompanying paper, Applicants have enclosed a request for an extension of time. If any additional fees are required, please charge our Deposit Account No. 06-2375, under Order No. 09807797 from which the undersigned is authorized to draw.

Dated: *January 13, 2004*

Respectfully submitted,

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